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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/539,148 | 06/16/2005 | Morgan Kanflod | AC-100 | 9266 |

7590 02/09/2007
Mark P. Stone
25 Third Street
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Stamford, CT 06905

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| EXAMINER |
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MACARTHUR, VICTOR L

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| ART UNIT | PAPER NUMBER |
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3679

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 02/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/539,148

Applicant(s)

KANFLOD

Examiner

Victor MacArthur

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/16/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Preamble-Intended Use

The preamble of claim 1 recite(s) functional intended use limitations that are not taken in combination with the positively recited structure as follows:

- In lines 1-2 of the preamble of claim 1, it appears that the applicant does not intend to positively claim “for connecting a threaded rock bolt to an impact rock drilling machine”. For purposes of examination the examiner has considered the claims without combination. “(T)he recitation of a new intended use for an old product does not make a claim to that old product patentable”, *In re Schreiber*, 44 USPQ2d1429 (Fed. Cir. 1997). Accordingly, the prior art meets the applicant’s claimed intended use merely by being capable of such intended usage regardless of whether or not such capability is expressly disclosed (i.e., wherein capability is inherent to the disclosed structure). If the applicant wishes to positively recite the above intended use phraseology then the limitation “for” should be deleted from line 1 of the claim.

Claim Objections

Claim 1 is objected to because of the following informalities:

- The phrase “said locking device cooperating” lines 10-11 of claim 1 refers to the intended use phraseology noted in the “Preamble-Intended Use” section above in a positive manner. Accordingly, the phrase should be replaced with --said locking device adapted to cooperate-- since references to a mere intended use must be functional in nature (i.e., “operable to”, “shaped for”, “configured for”, etc.). Note

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that positive reference to an intended use limitation renders the claim unclear as to what is being positively claimed and what is mere intended use. If the applicant intends for such phraseology to be positively recited then the preamble must be amended accordingly (e.g., by deleting the limitation "for" from line 1).

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ponto (U.S. Patent 1,701,985).

Claim 1. Ponto discloses (figs.1-7) a coupling sleeve (11), said sleeve comprising a first part (lower part of 11) provided with an internal thread (internal thread receiving 6) and a second part (upper part of 11) provided with an internal thread (internal thread receiving 5) characterized in that the second part comprises a locking device (19 and locking pin that extends therethrough as described in p.1, ll.66-68) arranged substantially transversely to a longitudinal axis of the coupling sleeve. Further more:

- The Ponto coupling sleeve is fully capable of performing the intended use of being used for connecting a threaded rock bolt to an impact rock drilling machine.

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- The Ponto internal thread is fully capable of performing the intended use of being used for connection of a rock bolt.
- The Ponto internal thread is fully capable of performing the intended use of being used for connection of a rock drilling machine.
- The Ponto locking device is fully capable of performing the intended use of being used for cooperating with a region on a rock drilling machine for preventing separation of the coupling sleeve and a rock drilling machine.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

VLM

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February 3, 2007

Daniel P Stodola

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